



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,921	12/12/2000	Mary L. Richardson	EMD0001-US	3793

28970 7590 05/31/2005

PILLSBURY WINTHROP SHAW PITTMAN LLP
1650 TYSONS BOULEVARD
MCLEAN, VA 22102

EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,921

Applicant(s)

RICHARDSON, MARY L.

Examiner

C. Michelle Colon

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-37,42-63 and 65-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-37,42-63 and 65-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to the communication received on February 11, 2005. Claims 1, 4, 27, 42, 45, 48, 53, 54, 56, 59, 62, 65 and 67 have been amended. Claims 3, 38-41 and 64 have been cancelled. Claims 1, 2, 4-37, 42-63 and 65-67 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 1, 4, 27, 42, 45, 48, 53, 54, 56, 59, 62, 65 and 67 are acknowledged.

The amendments are not sufficient to overcome the 35 U.S.C. 101 technological arts rejection because the references to using a computer in the claims are mere trivial recitations, which are unclear as to how the computers are used to perform the limitations. For example, in claim 1, the limitation, providing through a computer employer information about the employers, may be merely displaying employer information on a computer interface, which is a trivial use of technology. The use of computer/technology in the claims should be of more consequence to the overall process. Accordingly, the 35 U.S.C. 101 technological arts rejection of claims 1-14, 22-37, 42, 44-56 and 58-67 is maintained.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 2, 4-14, 22-37, 42, 44-56, 58-63 and 65-67 are rejected under 35

U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the steps of method claims 1, 2, 4-14, 22-37, 42, 44-56, 58-63 and 65-67 merely recite providing an employment placement service; however, the steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper and without the need of a computer or other technology.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present

Art Unit: 3623

case, the claimed invention uses employer and applicant information and criteria (i.e., concrete) to perform employment placement (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 2, 4-14, 22-37, 42, 44-56, 58-63 and 65-67 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-37, 42-63 and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.jobasia.com in view of www.replyto.com.

The following sources explaining the different aspects of www.jobasia.com are considered as describing one reference:

i. www.jobasia.com (February 1999, archived version) (referred to herein as reference A);

ii. Article, "Online job markets, most are middle professionals" from *HK Economic Times*, Oct 3, 1998, (referred to herein as reference B);

iii. Article, "Internet Update Asia 02/19/99," from *Newsbytes*, Feb 19, 1999, (referred to herein as reference C).

The following sources explaining the different aspects of www.replyto.com are considered as describing one reference:

- i. Article, "New Web Site Pays Job Seekers to Help Fill High Tech Job Openings" from *Business Wire*, Nov 22, 1999, (referred to herein as reference D);
- ii. Article, "New Web Site Pays \$50, \$500 or More for Your Resume" from *Business Wire*, July 27, 1999 (referred to herein as reference E).

As per claim 1, www.jobasia.com discloses a method for providing an employment placement service comprising the steps of:

broadcasting job listings of employers, wherein an employment placement service provider broadcasts the job listings (reference A, pages 2 and 4; reference C, page 1; www.jobasia.com provides job seekers with job listings from employers.);

providing through a computer employer information about the employers (reference A, page 4; www.jobasia.com provides job seekers with the ability to perform searches by company name.); and

exchanging applicant information between applicants and the employers using a computer (reference A, pages 4 and 7; Through their job ads, employers indicate how they want job seekers to contact them. Additionally, job seekers may submit their resumes online to apply for jobs. Job seekers access employer information through their online searches.); and

paying a bonus to an applicant who uses the employment placement service to locate an employer and is hired by the employer, wherein the employment placement

Art Unit: 3623

service provider pays the bonus to the applicant (reference B; Job seekers who are hired by an employer through the website are paid bonuses by www.jobasia.com).

www.jobasia.com discloses charging employers fees for posting job ads (reference A, page 6). www.jobasia.com does not expressly disclose charging the employers only for job listings that produce hirings. www.replyto.com discloses charging the employers only for job listings that produce hirings (reference E, page 1; www.replyto.com charges companies a percentage of the starting salary of the hiree.). At the time of the invention, it would have been obvious to a person of ordinary skill in the art for the employment placement service of www.jobasia.com to utilize a fee structure similar to the employment placement service of www.replyto.com where companies are only charged for hirings because doing so encourages companies to post more job listings since it is free. Encouraging companies to post more job listings provides job seekers a larger job pool to search from, thus enhancing the overall effectiveness of the job placement service, as indicated as a result by www.replyto.com on the bottom of page 1 of reference D.

As per claims 2 and 4, www.jobasia.com does not expressly disclose the method of claim 1, wherein the step of charging comprises charging the employers only for job listings that produce hirings for critical hire positions; or wherein the applicant must be hired for a critical hire position. www.replyto.com discloses charging the employers only for job listings that produce hirings (reference E, page 1; www.replyto.com charges companies a percentage of the starting salary of the hiree, thus the fee charged is dictated by the particular position filled.). As discussed by www.replyto.com (reference

Art Unit: 3623

D, page 1), only charging companies for hired positions makes it inexpensive and easy for employers to search for job candidates, thus encouraging employers to post more job listings and providing job seekers a larger job pool to search from. Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the job placement service of www.jobasia.com to charge employers only for job listings that produce hirings for critical hire positions because doing so encourages companies to submit more job openings since they don't have to pay until they hire someone for a particular position, which is a goal of www.replyto.com as indicated on reference D, page 1.

As per claim 5, www.jobasia.com discloses the method of claim 1, further comprising entering applicants in a drawing for a prize, wherein the applicants have been hired through the service during a specified period (reference B; Job seekers who find jobs through jobasia are entered in a lucky draw.).

As per claim 6, www.jobasia.com discloses the method of claim 5, wherein the applicants who have been hired through the service during a specified period are applicants for non-critical hire positions (reference A, pages 2 and 4; reference C, page 1; www.jobasia.com provides job seekers with job listings from employers for a variety of positions.).

As per claim 7, www.jobasia.com discloses the method of claim 1, wherein the employer information is uniform criteria for all of the employers (reference A, page 4; Employers can be searched on certain criteria.).

As per claim 8, www.jobasia.com does not expressly disclose the method of claim 1, wherein the employers are health care providers. However, employment placement applies to many industries, including the health care industry. Additionally, www.jobasia.com allows job seekers to search for positions in 36 job areas and over 87 industries (reference A, page 4). Thus, at the time of the invention, it would have been obvious for a health care provider to utilize the employment placement service of www.jobasia.com because, like many businesses, health care providers require qualified applicants to fill certain positions, which is a service www.jobasia.com provides.

As per claim 9, www.jobasia.com discloses the method of claim 1, wherein the step of providing employer information further comprises providing employer information about employers that are not posting job listings on the service (reference A, page 4; Job seekers may search for companies by name.).

As per claim 10, www.jobasia.com discloses the method of claim 1, further comprising the step of searching the job listings, the employer information, and the applicant information (reference A, page 4; reference C, page 1).

As per claim 11, www.jobasia.com discloses the method of claim 1, wherein the step of providing employer information comprises searching for an employer matching particular employer information desired by an applicant (reference A, page 4; reference C, page 1).

As per claim 12, www.jobasia.com discloses the method of claim 11, wherein if the searching does not return a matching employer, then the method further comprises the steps of:

(i) storing the particular employer information desired by the applicant; (ii) periodically searching for the particular employer information desired by the applicant; and (iii) notifying the applicant when the searching returns a matching employer (reference A, page 4; Job seekers can save search criteria in a personal profile and have the profile automatically updated when job ads match.).

As per claim 13, www.jobasia.com does not expressly disclose the method of claim 12, wherein the step of notifying the applicant comprises sending an email to the applicant. However, www.jobasia.com does disclose job seekers registering for the service with an email address and employers communicating with job seekers via email (reference A, pages 2 and 7). Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for applicants to be notified via email of job matches because doing so facilitates and expedites information to the applicants, thus making the service more efficient and effective.

As per claim 14, www.jobasia.com discloses the method of claim 12, further comprising the steps of:

storing particular employer information desired by multiple applicants and analyzing the stored particular employer information to provide information as to demand for certain employer criteria (reference A, page 4).

As per claim 15, www.jobasia.com discloses the method of claim 1, wherein the step of exchanging applicant information between applicants and employers comprises storing applicant qualifications in a database searchable by the employers (reference C, page 1).

As per claim 16, www.jobasia.com discloses the method of claim 15, further comprising searching the database for an applicant matching particular applicant qualifications desired by an employer (reference C, page 1).

As per claim 17, www.jobasia.com discloses the method of claim 16, wherein if the searching does not return a matching applicant, then the method further comprises the steps of:

(i) storing the particular applicant qualifications desired by an employer; (ii) periodically searching for the particular applicant qualifications desired by an employer; and (iii) notifying the employer when the searching returns a matching applicant (reference A, page 4; reference C, page 1; Users of the system may save search criteria in profiles and have the profiles automatically updated when matches are found.).

As per claim 18, www.jobasia.com discloses the method of claim 17, wherein the step of notifying the employer comprises sending an email to the employer (reference A, page 7; Employers may indicate a preference of how to be notified, which includes email.).

As per claim 19, www.jobasia.com discloses the method of claim 17, further comprising the steps of:

storing particular applicant qualifications desired by multiple employers and analyzing the stored particular applicant qualifications to provide information as to demand for certain specialties (reference A, page 6; The system maintains information about the demand for specialties, using the various profiles of users.).

As per claim 20, www.jobasia.com discloses the method of claim 15, wherein the qualifications are stored in an applicant file (reference A, page 4; Applicant profiles are maintained.). www.jobasia.com does not expressly disclose the applicant file is marked inactive such that the applicant file is not searched. However, www.jobasia.com discloses searching a database for specific criteria within the records. It is well known in the database art to set flags for records to indicate a certain status for the records. Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art to mark files inactive so they are not searched in order to facilitate the searching through the database, thus making the searching more efficient.

As per claim 21, www.jobasia.com does not expressly disclose the method of claim 1, wherein exchanging applicant information between applicants and employers is accomplished by electronic mail. However, www.jobasia.com does disclose job seekers registering for the service with an email address and employers communicating with job seekers via email (reference A, pages 2 and 7). Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for applicants to be notified via email of job matches because doing so facilitates and expedites information to the applicants, thus making the service more efficient and effective.

As per claim 22, www.jobasia.com discloses the method of claim 1, further comprising the step of charging the employers a subscription fee separate from charges for the job listings that produce hirings. (reference A, page 6; Employers are charged fees for ads.).

As per claims 23-26, www.jobasia.com does not expressly disclose the method of claim 1, wherein the step of broadcasting comprises distributing a paper that contains the job listings, wherein the paper includes a response card and wherein the step of exchanging applicant information comprises receiving response cards from the applicants. However, www.jobasia.com does disclose an automated fashion using computers and a network to broadcast job listings, provide employer information and receive responses from applicants, including telephone communication, which accomplishes the same result as the recited paper distribution (reference A, pages 2, 4 and 7; reference C, page 1). Thus, at the time of the invention, it would have been obvious to one of ordinary skill in the art to automate a well-known activity since it accomplishes the same result in a more efficient and expeditious way. It was known at the time of the invention that merely providing an automated way to replace a well-known activity, which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claims 27-37, 42-63 and 65-67 recite substantially similar limitations as claims 1-26 above. Therefore, claims 27-37, 42-63 and 65-67 are rejected on the same basis as claims 1-26 above.

Response to Arguments

7. Applicant's arguments are moot in view of the new grounds of rejections.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Thompson et al. (U.S. 6,675,151) discusses a system and method for substitute fulfillment;

Art Unit: 3623

- Donnelly, George. "Networking and the Net," *CFO, The Magazine for Senior Financial Executives*, August 1999 [retrieved from Dialog] discusses electronic job listings on the Internet;
- LaPlante, Alice. "America's most wanted," *Computerworld*, Oct 5, 1998 [retrieved from Dialog] discusses ways to acquire talented IT professionals such as using bonuses as well as Internet job postings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for Patents

Art Unit: 3623

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to:

703-872-9306

[Official Communications; including After Final
communications labeled "Box AF"]

571-273-6727

[For status inquiries, draft communication, labeled
"Proposed" or "Draft"]

Hand delivered responses should be brought to:

United States Patent and Trademark Office

Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22314


cmc

May 16, 2005


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600